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10/083,110	02/27/2002	Wilfried Jud	ATM-2215	4881

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Fisher Christen & Sabol
Suite 1108
1725 K Street NW
Washington, DC 20006

EXAMINER

JACKSON, MONIQUE R

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1773

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Please find below and/or attached an Office communication concerning this application or proceeding.

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10/083110

EXAMINER

ART UNIT

PAPER

20070119

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The Examiner's Answer dated 11/3/05 is hereby vacated. Please find attached a new Examiner's Answer including a complete list of prior art relied upon by the Examiner, correcting a typographical error in the Third Grounds of Rejection, and separating the Response to Arguments with regards to the Fourth, Fifth and Sixth Grounds of Rejection.

Monique R. Jackson
Primary Examiner, TC 1700
January 19, 2007



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GROUP 1700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/083,110
Filing Date: February 27, 2002
Appellant(s): JUD ET AL.

Virgil Marsh
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/12/05 appealing from the Office action mailed 6/18/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. Serial Number 09/505,713, Appeal Number 2006-1061, request for reconsideration of board decision filed 8/2/06.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

4,407,689	OHTSUKI et al	10-1983
5,589,275	BREITLER et al	12-1996
5,591,520	MIGLIORINI et al	1-1997
6,090,471	ABRAMS	7-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

First Grounds of Rejection

Claims 30, 34, and 38 stand rejected under 35 U.S.C. 102(b) as being anticipated by Migliorini et al (USPN 5,591,520) for the reasons recited in the prior office action mailed 12/17/03 and restated below.

Migliorini et al teach a high barrier metallized film with excellent bonds strengths comprising a coextruded multilayer film of a layer of polyamide (PA) adjacent and aggressively adhered to a layer of polypropylene (PP), and optionally a heat seal layer, such as ethylene propylene (EP) or ethylene propylene butene (EPB), applied on the polypropylene layer opposite the polyamide layer, and a metal layer such as aluminum applied to the polyamide surface wherein the metallized film may be subsequently extrusion laminated on the metal surface with a low density polyethylene film (LDPE) (*meets the limitation "first functional layer containing a first plastic film that is a polyolefin or extrusion layer of a polyolefin or one or more lacquer layers"*), such that the structure of the resulting film is: LDPE/metal/PA/PP/EP or EPB (Abstract; Col. 1, lines 10-64; Col. 2, lines 39-42; Col. 3, line 58-Col. 4, line 14; Example)

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wherein the Examiner takes the position that the polyamide/polypropylene film taught by Migliorini would inherently meet the instant limitation with regards to delamination during sterilization given that the film is formed by **coextrusion** as instantly claimed and wherein the aluminum layer taught by Migliorini et al reads upon the term “aluminum foil” considering the recited claims do not limit the term “foil” to any particular aluminum layer thickness.

Second Grounds of Rejection

Claims 30, 34, and 38-45 stand rejected under 35 U.S.C. 102(b) as being anticipated by Breitler et al (USPN 5,589,275) for the reasons recited in the prior office action mailed 12/17/03 and restated below.

Breitler et al teach a composite material suitable for sterilization containers or packages wherein the composite contains a metal layer on both sides of which is a plastic layer wherein the metal layer is a metal foil, preferably aluminum or aluminum alloy with an aluminum purity of most preferably 99.5% or higher, including AA8014, AA8079 or AA8101, having a thickness of 8-120 μ m; wherein the plastic layer(s) is a polyamide-based thermoplastic containing polyamide with a thickness of 20-50 μ m (Abstract; Col. 1, lines 19-20; Col. 3, lines 1-22 and lines 66-67.) Breitler et al teach that the plastic layers on both sides of the metal layer may include composites of two or more films or layers wherein the polyamide-based thermoplastic layers may additionally and independent of each other be provided with an outer lying sealable layer and/or barrier layer of thermoplastics, such as a polypropylene sealable layer, wherein the sealable layers are sealable films deposited via adhesives, applied by lamination or lamination coating wherein the thickness of the sealable films may be 6-100 μ m thick and furthermore, one

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or more layers, e.g. 1 to 10 μ m thick, of a sealing layer coating may be deposited on the plastic composite (Col. 4, lines 1-38.) Breitler et al further teach that a single or double-sided sealable composite may be obtained by single or double-sided coextrusion of the plastic layers, wherein in that connection, it is useful for the plastic layers to contain or comprise a polyamide-based thermoplastic and at least one polyamide layer to feature a sealing layer on at least one side, i.e. **each layer of polyamide thermoplastic may be covered with a sealable layer, such as polypropylene, on one side or both sides, independent of the other layers** (Col. 4, lines 36-45.) Breiter et al teach that to join the aluminum foil or to bond the plastic films or individual layers to each other, an adhesive coating and/or bonding primer are usually employed wherein a suitable adhesive is a maleic-anhydride modified polypropylene, and suitable bonding agents are epoxy or urethanes, wherein the bonding agent or primer may be for example applied in amounts of 0.1-10g/m², usefully 0.8-6g/m² or the adhesive layer has a thickness of 1-12 μ m or applied in an amount of 0.1-14 g/m² (Col. 5, lines 3-47.) Breitler et al further teach that the composite material may also feature a sealing layer such as PET on one or both sides of the composite independent of the other layers, with a thickness of 6-100 μ m (Col. 4, lines 20-35.) Breitler et al teach a number of layer arrangements wherein the plastic films may be formed by warm coating or coextrusion and may be subjected to stretch-drawing, to produce a composite film useful in manufacturing packaging and parts of packaging such as packaging containers, base parts, blister packs, for storing or packaging foodstuffs or pharmaceutical products (Col. 5, line 48-Col. 6, line 23; Col. 6, line 65-Col. 7, line 33.) With regards to the limitation "lacquer", the Examiner takes the position that the synthetic coating layers taught by Breitler et al read on the term "lacquer" layer(s). Hence, according to a broad interpretation of Breitler et al, the composite may have the

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following structure: coextruded (PP/PA/PP)/optional primer or adhesive/metal foil/optional primer or adhesive/coextruded (PP/PA/PP) which reads on the above recited claims given that a polypropylene layer which is a polyolefin may be adjacent the metal foil directly or via a primer or adhesive and given that the instant claims do not exclude the incorporation of additional layers.

Third Grounds of Rejection

Claims 39-45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Migliorini et al (USPN 5,591,520) in view of Breitler et al for the reasons recited in the prior office action mailed 12/17/03 and restated below.

The teachings of Migliorini et al are discussed above. Though Migliorini et al teach that the composite comprises a metal or aluminum layer formed by metallization, Migliorini et al does not teach that the metal layer is formed by a metal **foil** or aluminum **foil** having the instantly claimed properties of Claims 39-42. However, Migliorini et al do teach that a metallized layer is functionally equivalent to a metal foil layer in terms of providing barrier properties in a multilayer composite film wherein the metal layer thickness affects the barrier properties of the film, hence based on the teachings of Migliorini et al, one having ordinary skill in the art at the time of the invention would have been motivated to utilize a metal or aluminum foil layer in the invention taught by Migliorini et al based on the desired barrier properties for a particular end use of the packaging film. Further, one having ordinary skill in the art would have been motivated to utilize any conventional metal foil or aluminum foil layer utilized in the art wherein Breitler et al teach the use of an aluminum foil layer having the instantly claimed properties in a

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composite barrier packaging film and hence, one skilled in the art would have been motivated to utilize the preferred metal foil taught by Breitler et al in the composite film taught by Migliorini et al.

Fourth Grounds of Rejection

Claims 30-38 and 43-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuki et al (USPN 4,407,689) for the reasons recited in the prior office action mailed 12/17/03 and restated below.

Ohtsuki et al teach a laminated member comprising a metal foil laminated to a thermoplastic film via a polyolefin-based adhesive wherein the metal foil is made of aluminum with a thickness of about 5 to 1,000um, may be subjected to chemical treatment (primer) on the surface of the metal foil, and may be backed with a heat-resistant film such as a polyamide or polyester film (*also reads on term "lacquer layer"*) since the metal foil is generally low in mechanical strength, wherein a print layer may be formed between the heat-resistant layer and the aluminum foil (Abstract; Col. 2, line 25-Col. 4.) Ohtsuki et al teach that the thermoplastic film may be a single resin film, for example, polyolefin such as polyethylene or polypropylene, polyamide, polyester, polyvinyl chloride, polyvinylidene chloride, polybutadiene, polycarbonate, an ethylene-vinyl acetate, or polyvinyl alcohol or a composite film produced therefrom by coextrusion (Col. 3, lines 20-32.) Ohtsuki et al further teach that the laminated product may be used for the production of a retort sterilization package wherein when it is used as a material for packaging food to be sterilized in a retort, it is preferred to use high density polyethylene or polypropylene as the polyolefin (Col. 5, lines 22-27.) Hence, Ohtsuki et al teach a composite having the following structure: polyester/print layer/primer/aluminum foil/primer/polyolefin

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adhesive/thermoplastic film wherein the teachings of Ohtsuki et al suggest that the thermoplastic film may be a coextruded film of two different polymers such as polypropylene and polyamide (Col. 3, lines 20-32; Col. 39-42) and therefore one skilled in the art at the time of the invention would have been motivated to utilize a coextruded film of any two polymers disclosed by Ohtsuki et al including polypropylene and polyamide. With regards to Claim 32, though Ohtsuki et al teach that the polyester backing film is present to provide improved mechanical strength, Ohtsuki et al does not specifically teach that the polyester film is monoaxially or biaxially oriented or that the polyester is formed from PET or PPT. However, it is well known and conventional in the art to orient a polymer film mono- or bi-axially to improve the mechanical strength of the film hence given that Ohtsuki et al teach that the polyester film is provided because the metal foil lacks mechanical strength, one having ordinary skill in the art at the time of the invention would have been motivated to improve the mechanical strength of the polyester film and resulting resin backed metal foil by orienting the polyester film as well known and conventional in the art. Further, one having ordinary skill in the art at the time of the invention would have been motivated to utilize any polyester film conventionally utilized in producing packaging composite materials wherein PET and PPT are obvious species of polyester film utilized in the art to provide mechanical strength to a composite film.

Fifth Grounds of Rejection

Claims 39-42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuki et al in view of Breitler et al for the reasons recited in the prior office action mailed 12/17/03 and restated below.

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The teachings of Ohtsuki et al are discussed above. Though Ohtsuki teach that the metal foil may be an aluminum foil, Ohtsuki et al does not specifically teach that the aluminum foil has the properties as instantly claimed. However, one having ordinary skill in the art would have been motivated to utilize any conventional aluminum foil utilized in the art wherein Breitler et al teach the use of an aluminum foil layer having the instantly claimed properties in a composite barrier packaging film and hence, one skilled in the art would have been motivated to utilize the preferred aluminum foil taught by Breitler et al in the composite barrier film taught by Ohtsuki et al.

Sixth Grounds of Rejection

Claim 48 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuki et al in view of Abrams for the reasons recited in the prior office action mailed 12/17/03 and restated below.

The teachings of Ohtsuki et al are discussed above. Though Ohtsuki et al teach that the aluminum foil layer may comprise a print layer and a polyester or polyamide overcoat or backing film, Ohtsuki et al does not teach that the print layer is provided on the polyester backing film and then an overcoat layer is provided on the print layer. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize any combination of print and polyester layers wherein Abrams teaches that a sterilizable packaging composite can comprise a print layer to provide desired product information for a particular packaging end use and that a protective overcoat or lacquer layer can be provided over the print layer to protect the print layer during sterilization. Therefore, one having ordinary skill in the art at the time of the invention would have been motivated to include a print layer on either side of the polyester film

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taught by Ohtsuki et al to provide desired product information or decorative properties, wherein the print layer is further provided with a protective overcoat layer to protect the print layer during sterilization as taught by Abrams.

(10) Response to Argument

First Grounds of Rejection

With respect to Migliorini et al, the Appellants argue that Migliorini allegedly does not teach the plastic of the second functional layer (c) that consists of a coextrudate of polyamide and polypropylene. However, the Examiner notes that the Appellants appear to refer to the Migliorini references in a piecemeal fashion as opposed to a reference as a whole. As discussed in detail above, Migliorini et al clearly teach a coextruded film comprising the instant layers wherein the composite specifically exemplified by Migliorini et al includes an additional EPB layer that Migliorini et al clearly teaches is an optional seal layer. Hence, though Migliorini et al do not specifically provide an example having the instantly claimed structure without the EPB layer, the instant invention having a “second functional layer” consisting of a coextrudate of just polyamide and polypropylene would have been clearly envisaged by the teachings of Migliorini et al considering Migliorini et al clearly teaches that the EPB layer is an optional layer and/or considering that Migliorini et al clearly teaches that the composite includes a polyamide layer aggressively adhered to a polypropylene layer and the composite may be formed by coextrusion.

Second Grounds of Rejection

With respect to Breitler et al, the Appellants continue to argue that Breitler et al allegedly does not disclose any member of Appellants’ first functional layer and that the Examiner has allegedly improperly interpreted the teachings of Breitler et al. The Appellants argue that one

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skilled in the art would not have reasonably interpreted the specified sections in the same manner as the Examiner, that nowhere does Breitler et al disclose a polypropylene layer between a metal layer and a polyamide layer, and that the recitation at Col. 4 of Breitler et al only teaches polypropylene layers on the outer sides of the composite and not the outer sides of the polyamide layer including between the polyamide layer and the metal layer. However, as previously stated, the Examiner maintains her position with regards to Breitler et al and specifically points to lines 36 to 44 of Column 4 of Breitler which read:

“A single or double-sided sealable composite is obtained by single or **double sided coextrusion of the plastic layers with e.g. a polypropylene/polyethylene copolymer.**

In that connection it is useful for the plastic layers to contain or comprise of a polyamide-based thermoplastic to feature a sealing layer on at least one side i.e. each layer of polyamide-based thermoplastic **may be covered with a sealable layer on one or both sides, independent of the other layers.**” (Emphasis added.)

The Examiner contends that this recitation clearly states that **each layer** of polyamide may be provided on **one or both sides** with a sealable layer, or polypropylene per Col. 4, line 24, independent of the other layers, **not** that each layer of polyamide may be provided **only on one side** with a sealable layer such that the composite is provided with an outerlying sealable layer on one or both sides as interpreted by the Appellants. Hence, Column 4, lines 36-44 states that each polyamide layer can be covered with a sealable layer on one or both sides, independent of the other layers, wherein one or both sides obviously refers to the polyamide layer not the composite as argued by the Appellants. If one considers the Appellants’ interpretation that the polypropylene is only on one side of the polyamide layer, namely the outer lying surface of the

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polyamide layer, why would the reference state that the plastic layers are subjected to double-sided coextrusion wherein double-sided coextrusion would provide a polypropylene layer on both sides of the polyamide layer? Further, why would the reference state that at least one polyamide layer be provided on at least one side with a sealing layer, further indicating that the polyamide layer can be provided on both sides with a polypropylene layer? Lastly, if the Appellants' interpretation that the polypropylene sealable layer is only provided on the outer lying surfaces of the polyamide layers, wouldn't the statement "each layer of polyamide-based thermoplastic may be covered with a sealable layer on one or both sides, independent of the other layers" have read "may be covered with a sealable layer on the outer lying side, independent of the other layers" not "on one or both sides"? Therefore, the Examiner maintains that contrary to the Appellants' arguments, a fair reading of Brietler et al by one having ordinary skill in the art would nevertheless lead one skilled in the art to the interpretation that a sealable or polypropylene layer can be provided on **either or both sides of each polyamide layer** independent of other layers and hence Breitler et al when taken as a whole does in fact teach polypropylene layers between the polyamide plastic layers and the metal foil as in the instant invention.

Third Grounds of Rejection

In terms of the obviousness rejection over Migliorini in view of Breitler et al, the Appellants first argue that Migliorini et al and Brietler et al do not teach the functional layers of the instant composite as argued in the First and Second Grounds of Rejections as recited above however the Examiner maintains her position for the reasons as stated above with regards to these functional layers. The Appellants further argue that the Examiner's attempt to show

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motivation fails because Migliorini allegedly teaches away from the instant invention by showing improvements in using a metallized layer in place of a metal foil, however, though Migliorini teaches improvements based on particular desired characteristics of the final film, Migliorini clearly provides a suggestion that a metallized layer and a metal foil are both utilized for the same purpose in packaging films, namely barrier properties, and hence the Examiner maintains that one skilled in the art at the time of the invention would have been motivated to utilize a metallized layer or a metal foil layer given the reasonable expectation of success, considering both are known to provide barrier properties and hence are functional equivalents in the art.

Fourth Grounds of Rejection

With respect to Ohtsuki et al, the Appellants argue that Ohtsuki et al do not recognize the problem that the instant invention solves, do not teach that the coextruded layers have a bond sufficient to preventing delamination during sterilization, and provides a generic teaching of various components of the instant invention such that a broad number of possible arrangements are suggested with no direction to select Appellants' combination. However, the Examiner notes that Ohtsuki et al clearly teach that the resulting composite may be subjected to sterilization and utilized in producing sterilized packaging film, hence, though Ohtsuki et al do not explicitly recite that the two coextruded layer do not delaminate, given that Ohtsuki et al clearly teach subjecting the film to sterilization resulting in a **composite that is suitable for sterilized packaging**, the Examiner takes the position that Ohtsuki et al do in fact suggest that the coextruded layers can be subjected to sterilization and hence do not delaminate. Further, the Examiner takes the position that though Ohtsuki et al provides a generic teaching of the

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invention and lists various materials that can be utilized, the list of materials is small enough that one skilled in the art would be directed to Appellants' invention given the suggestion of Ohtsuki et al to utilize the materials of the instantly claimed invention and given the reasonable expectation of success.

Fifth Grounds of Rejection

With respect to Ohtsuki et al in view of Breitler et al, the Appellants argue that the combination of Ohtsuki et al in view of Breitler et al do not result in the appellants' invention given the appellants' arguments presented in response to the Fourth Grounds of Rejection. However, as stated above, the Examiner takes the position that Ohtsuki et al do in fact suggest that the coextruded layers can be subjected to sterilization to form a sterilized packaging composite film and hence do not delaminate, and further though Ohtsuki et al provides a generic teaching of the invention and lists various materials that can be utilized, the list of materials is small enough that one skilled in the art would be directed to Appellants' invention given the suggestion of Ohtsuki et al to utilize the materials of the instantly claimed invention and given the reasonable expectation of success. The Appellants further argue that the Examiner has not provided a showing of the necessary motivation to combine the two rejection references in order to establish a *prima facie* case of obviousness. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347,

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21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ohtsuki et al teaches that the metal foil in the composite may be aluminum foil but do not specifically teach the claimed aluminum foil properties. However, Breitler et al teach that an aluminum foil with the claimed properties is preferred in a composite barrier packaging film and hence the Examiner maintains her position that one having ordinary skill in the art at the time of the invention would have been motivated to utilize the preferred aluminum foil taught by Breitler et al, or any other conventional aluminum foil utilized in the art, to produce the barrier packaging film taught by Ohtsuki et al.

Sixth Grounds of Rejection

With respect to Ohtsuki et al in view of Abrams, the Appellants argue that Abrams does not cure the deficiencies of Ohtsuki et al and appear to argue the Abrams reference separately as opposed to in combination with Ohtsuki et al as presented in the rejection. The Appellants argue that Abrams does not appear to address the problem of delamination during sterilization, however, as discussed above, the Examiner takes the position that the primary reference, Ohtsuki et al, does in fact suggest that the coextruded layers can be subjected to sterilization to form a sterilized packaging composite film and hence do not delaminate. The Appellants also argue that the Examiner has no basis for not using the inner plastic layer taught by Abrams, however, the Examiner notes that Abrams was relied upon to support her position that one skilled in the art at the time of the invention would be motivated to include any number of print layers, in general, for product information or decorative properties, as well as a protective overcoat layer to provide protection to the print layer as taught by Abrams, not to provide a teaching of the claimed composite structure which, as discussed previously, is already suggested by the primary reference Ohtsuki et al.


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(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Monique R. Jackson
Primary Examiner
Technology Center 1700
January 19, 2007

**MONIQUE R. JACKSON
PRIMARY EXAMINER**

Conferees:


Carol Chaney


Terrell Morris

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILFRIED JUD and HANS-RUDOLF NAGELI

Appeal No. 2006-1061
Application No. 09/505,713

HEARD: May 09, 2006

Before KRATZ, TIMM and JEFFREY T. SMITH, ***Administrative Patent Judges.***
JEFFREY T. SMITH, ***Administrative Patent Judge.***

DECISION ON APPEAL

Applicants appeal the decision of the Examiner finally rejecting claims 38 to 53, all of the pending claims. We have jurisdiction under 35 U.S.C. §134.¹

¹ In rendering this decision, we have considered Appellants' arguments presented in the Brief, filed February 2, 2004.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Breitler et al. (Breitler)	5,589,275	Dec. 31, 1996
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Muggli ²	5,968,663	Oct. 19, 1999
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Ullmann's Encyclopedia of Industrial Chemistry, 1998 VCH, vol. A11, pp. 85, 86, 93, 105 and 108-108. (Ullmann)

The Examiner entered the following rejections:

(I). Claims 38-43 stand rejected under 35 U.S.C. § 102 (b) as anticipated by Breitler. (Answer, pp. 3-4).

(II). Claims 38-53 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Breitler and Ullmann. (Answer, pp. 4-6).

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review leads us to conclude that the Examiner's § 102 rejection is not well founded however, the § 103 rejection is well founded. Our reasons follow.

2. The Examiner as rebuttal evidence to Appellants' arguments cited this reference. The reference has not been included in the statement of the rejection.

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Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants concerning the above-noted rejections, we refer to the Answer and the Brief.

We initially note that Appellants assert that for purposes of appeal the claims are grouped as follows: (I) 38-45 and 47-50, (II) 46, (III) 51, (IV) 52 and 53. We will consider these groups of claims separately to the extent that Appellants have argued them. Any claims not properly separately argued will stand or fall with the selected representative claim. See 37 CFR § 1.192(c)(7)(2003)(now 37 CFR § 41.37(c)(1)(vii), effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)); and *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002).

OPINION

Appellants' invention relates to a sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer. Claim 38, which is representative of the claimed invention, appears below:

38. A sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer,

the composite film having a layer structure containing one on top of the other in the following sequence:

(a) a first functional layer containing a plastic film that is a polyester, a polyamide, or a polyolefin, or an extrusion layer of a polyolefin, or one or more lacquer layers, or print and lacquer layers, or print layers;

(b) a metal foil having a thickness of 5 to 100 μm ; and

(c) a second functional layer containing a plastic layer that is a layer comprising a coextrusion-coated, a coextruded, and/or an extrusion-laminated film having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer, said first polypropylene is directly bonded to metal foil (b) or is bonded to metal foil (b) by means of a bonding agent layer or a laminate adhesive layer, and, optionally, a primer layer is on at least one surface of metal foil (b).

The Examiner rejected claims 38-43 as anticipated by Breitler. Claim 38 is directed to a sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer. The composite film has a layer structure containing layers one on top of the other in a specific sequence.

We agree with Appellants that the Examiner has not established a *prima facie* case of anticipation with respect to the subject matter of the rejected claims. (Brief, p. 6). The Examiner acknowledges in the discussion of the § 103 rejection that there must be some selection from the teachings of

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Breitler to arrive at the claimed invention. (See Answer, p. 5). As such, Breitler does not anticipate the claimed subject matter because it does not provide a disclosure sufficiently specific to direct one skilled in the art to the claimed combination without any need for picking and choosing. **See *In re Arkley***, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972). Accordingly we determine that the Examiner has not established a *prima facie* case of anticipation with respect to the subject matter of claims 38-43.

However, our determination that the disclosure of Breitler does not anticipate the subject matter of the claims does not preclude a finding that the disclosure of Breitler would have rendered the subject matter of the claims on appeal *prima facie* obvious under 35 U.S.C. § 103 (a). **See *Arkley***, *supra*.

Claims 38-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Breitler in view of Ullmann. We affirm the rejection essentially for the reasons presented by the Examiner and add the following primarily for emphasis.

We note that Appellants' representative in the Hearing on May 9, 2006, indicated that the appeal as to the subject matter of claim 51 is withdrawn. Thus, we summarily affirm the Examiner's § 103 rejection of claim 51.

We now turn to the rejection of the remaining claims.

The Examiner found that Breitler teaches a composite film containing a metal foil, preferably aluminum, with plastic films on both sides thereof. According to the Examiner, Breitler teaches the general layer structure as instantly claimed with layer thickness within or comprising the instantly claimed ranges. Breitler teaches utilizing optional adhesive, bonding and/or primer layers to bond plastic layers to each other and/or to the metal foil. The Examiner asserts that "[t]hough Breitler et al discloses all of the layers, layer materials and layer thickness as instantly claimed, Breitler et al does not specifically limit the invention to the specific composite film combination as instantly claimed, however, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize any of the structures disclosed by Breitler et al selecting from the disclosed materials taught by Breitler et al based on the desired film properties for a particular end use." (Answer, p. 5). The Examiner determined that through routine

experimentation it would have been obvious to a person of ordinary skill in art to determine the optimum thickness of the individual layers because layer thickness is a result-effective variable affecting the barrier, mechanical, adhesion and sealing properties of the resulting composite. (Answer, p. 5). Further, the Examiner determined, citing the Ullmann reference, that utilization of an appropriate laminating method, such as extrusion laminating, lamination coating, coextrusion or laminating via adhesives would have been obvious to a person having ordinary skill in the art. (Answer, p. 5).

The major point of disagreement between Appellants and the Examiner is the description of the subject matter of Breitler in column 4. Appellants argue that:

The Examiner has incorrectly contended that column 4 of Breitler et al. discloses appellants' second functional layer (c).

The disclosure in column 4 of Breitler et al., when taken in context with the entire disclosure of such patent, refers to a sealable layer on one or both sides of its composite material (and not to a sealable layer on both sides of a polyamide layer of said composite material). Appellants have presented below an analysis of column 4 and its meaning in the context of the whole disclosure of Breitler et al. and the wording in such column. Appellants have also presented court and Board decisions on it being in error to take portions of a prior art reference out of context. Further, appellants have presented quotations from

documents from the prosecution/examination of Breitler et al. to support appellants' position. [Brief, p. 5].

Appellants further argue, Brief page 13, that "[a]ll references to sealing layers in such text [of column 4] are exclusively to sealing layers, located on the outer surfaces of the composite material, i.e. on the outer surface of the plastic layers of the composite material."

Appellants' argument is not persuasive. Breitler provides an extensive discussion of the various layers that form the described composite material. (See columns 2-7). Regarding the plastic layer, Breitler discloses:

The plastic layers may include e.g. monofilms or monolayers and composites of two or more films or layers of plastics such as polyamides, polyamide mixtures or mixed, block, grafted or copolyamides. [Column 3, lines 19-22]

The plastic layers on both sides of the metal layer, in particular the polyamide-based thermoplastics may additionally, and independent of each other, be provided with an outer lying sealable layer and/or a barrier layer of thermoplastics. [Column 4, lines, 9-13]

A single or double-sided sealable composite is obtained by single or double-sided coextrusion of the plastic layers with e.g. a polypropylene/polyethylene copolymer.

In that connection it is useful for the plastic layers to contain or comprise of a polyamide-based thermoplastic and at least one a polyamide-based thermoplastic to feature a sealing layer on at least one side i.e. each layer of polyamide-based thermoplastic may be covered with a sealable layer on one or **both sides, independent of the other layers**. [Column 4, lines 36-45].

(Emphasis added)

Breitler teaches a person of ordinary skill in the art, from the above cited portions of the disclosure, *inter alia*, that the plastic (polyamide) layer may be composites of two or more layers and that the sealing of the plastic layer on one or both sides is independent of the other layers. As such, a person of ordinary skill in the art would have reasonably expect that both sides of the plastic layer described by Breitler could have been encased by sealing layers. "For obviousness under ' 103, all that is required is a reasonable expectation of success." *In re O'Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). This is especially true in the present case because Breitler, like the present application, adheres the materials of the sealing layer to the metal foil layer. (See column 5). Consequently, a person of ordinary skill in the art would have recognized that if the sealing layers were applied to both sides of the polyamide layer the (encased) plastic layer would have been suitable for bonding to the metal layer.

Appellants have presented the declaration of Breitler to discuss the descriptions appearing in column 4 of the cited U.S. Patent No. 5,589,275 (Breitler). The declarant states

Such text [column 4, lines 9-13] is not discussing the plastic layers by themselves but only as components in the structure of the basic composite material. The use of the phrase "outer lying sealable layer" refers only to the outside surfaces of the basic composite material (i.e., the outside surface of each of the plastic layers). The words "outer lying" refer only to the side of each of the plastic layers away from the metal foil." (Paragraph 6)

Such text [column 4, lines 36-45] only discusses the basic composite material, placement of a sealable layer on the outer or outside surface of at least one of the plastic layers in the basic composite method. Such text does not refer to one or both of [the] sides of a plastic layer (in the composite material) having a sealable layer thereon—such is not part of the invention described in U.S. Patent No. 5,589,275. (Paragraph 7).

The statements of the declarant are not persuasive of patentability.

The declarant did not indicate that the description of Breitler was not suggestive of treating each layer of the composite independent of other layers. A person of ordinary skill in the art would have reasonably interpreted the description of Breitler as suggesting that the plastic (polyamide) layer was formed from composites of two or more layers. A person of ordinary skill in the art would have also reasonably interpreted that the description of Breitler suggested that the plastic (polyamide) layer contained sealing layers on

both sides, independent of the other layers in the composite material.³ It is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art. **See *In re Fritch***, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992). The intention of the patentee not to include specific subject matter in the described patent does not detract from the suggestive teachings therein.

The Examiner cited the Ullmann reference for teaching that the formation of plastic multilayer films by the process of extrusion laminating, lamination coating, coextrusion and laminating with adhesives were known. (Answer, p. 5). Breitler discloses the processes such as those described in Ullmann are suitable for forming composite materials used in packaging. (Column 6, lines 21-24). Thus, Appellants' arguments that there is no motivation to combine Breitler and Ullmann, Brief pages 27, 32 and 33, are not persuasive.

Appellants, Brief page 35, questions whether the Muggli reference is part of the § 103 rejection. The Muggli reference has not been included in

3. We note that Appellants' interpretation of the description of Breitler as having a sealing layer on the outside surfaces of the basic composite material is also consistent with the description of the reference.

the statement of the rejection by the Examiner. The Examiner relied on this reference as rebuttal evidence to Appellants' arguments. (Answer, p. 9).

Appellants argue that, because the Examiner has not addressed on the record the level of skill in the art, the § 103 rejection is fatally defective. (Brief, p. 36). "While it is always preferable for the factfinder below to specify the level of skill it has found to apply to the invention at issue, the absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown.'" **Okajima v. Bourdeau**, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001), (quoting **Lifton Indus. Prods., Inc. v. Solid State Sys. Corp.**, 755 F.2d 158, 163, 225 USPQ 34, 38 (Fed. Cir. 1985)). Appellants have not explained, and it is not apparent, why the applied prior art does not reflect an appropriate level of skill in the art.

For the above reasons and those expressed by the Examiner, we determine that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 38-45 and 47-50.

Regarding claims 46, 52 and 53, Appellants argue that Breitler does not disclose or suggest a polypropylene layer between the metal foil and the

polyamide layer. (Brief, pp. 37-40). This is essentially the same argument presented in the discussion of claim 38. As stated above, Breitler is suggestive of a composite material comprising a sealing layer on both sides of the plastic (polyamide) layer. Breitler discloses the sealing layer can be formed from polypropylene. (Column 4, lines 21-35). Thus, we affirm the rejection of claims 46, 52 and 53.

After considering all the evidence, with due consideration to the Appellants' arguments and evidence, we determine that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 38-53, which has not been sufficiently rebutted by Appellants.

CONCLUSION

The rejection of claims 38-43 under 35 U.S.C. § 102 (b) as unpatentable over Breitler is reversed. The rejection of claims 38-53 under 35 U.S.C. § 103 (a) as unpatentable over Breitler and Ullmann is affirmed.

Appeal No. 2006-1061
Application No. 09/505,713

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED


PETER F. KRATZ
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge


JEFFREY T. SMITH
Administrative Patent Judge

**BOARD OF PATENT
APPEALS
AND
INTERFERENCES**

JTS/sld

Appeal No. 2006-1061
Application No. 09/505,713

FISHER CHRISTEN & SABOL
1725 K STREET NW
SUITE 1401
WASHINGTON, DC 20006

Application No. 10/083,110

Accordingly, it is

ORDERED that the application is returned to the examiner to either:

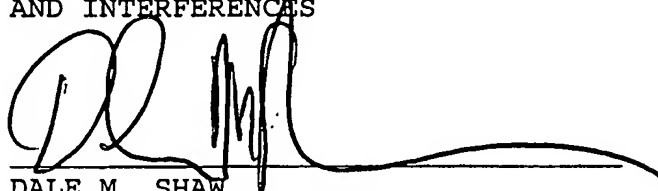
(1) reopen prosecution to address the new ground of rejection, or

(2) to obtain approval from a TC Director or appropriate designee; and it is

FURTHER ORDERED that the examiner vacate the Examiner's Answer mailed on November 3, 2005, and submit a new Examiner's Answer identifying the prior art relied upon under the heading of "Evidence Relied Upon," and for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:


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